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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/662,378 | 09/12/2000 | Stephan Meyers | 4925-52 | 8857 |

7590 12/29/2004

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| EXAMINER |
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TRAN, TONGOC

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| ART UNIT | PAPER NUMBER |
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2134

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 09/662,378 | Applicant(s) MEYERS, STEPHAN | |
| | Examiner Tongoc Tran | Art Unit 2134 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's amendment filed on 6/1/2004. Claims 1-21 are pending.

Response to Arguments

2. Applicant's arguments filed on 6/1/2004 have been fully considered but they are not persuasive.

Applicant contends that the cited prior art, Mott et al., fails to teach or suggest the claimed method steps of "registering said digital object as being in use by said access device" or "denying further transmission of said digital object to any other access device while said digital object is in use by said access device" as recited in method claim 1 and the same argument applied to apparatus claim 12. Mott teaches that before the request from the client system is authorized and the digital information is downloaded, the library server must verify that the client computer system is an authorized client (col. 11, lines 25-31, Mott further teaches that "a targeting protocol is a means and method for limiting the playback of digital information content...and the download of player operating code to a specific player..." (col. 12, lines 19-23), "Upon receipt of data from library server, the player checks if its player identifier included in the header...preventing unauthorized playback of content". This suggests that if the client system is not registered with the library server, and if the downloaded content does not contains the required unique code designed for specific registered playback device, the playback device can not access the digital information. If the digital content is targeted to specific device with specific

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“unique” code, it would inherently limiting other device from accessing the content. The same argument also applies to Applicant’s remark for claims 2, 10, 13 and 17.

Applicant further contends that Mott fails to teach that the content of digital information is distributed from a form specific to the type of access device as recited in claim 4. Mott teaches each library server can be configured to support a specific type of digital information content and request for content needs to be verified by authorization server (col. 15, lines 57-67) and the “authentication process ...validate the link between the mobile playback device and the library server...prior to user access to the library server content” (col. 17, lines 21-25). Therefore, it would be inherent to distribute the digital information from a form specific to the type of access device in order for the playback device to access the transmitted information.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

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Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-17 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Mott et al. (U.S. Patent No. 6,170,060, hereinafter Mott).

In respect to claim 1, Mott discloses a method of distributing digital information, comprising:

registering a digital object containing said digital information; registering an access device for receiving said digital object; requesting that access to said digital object be granted to said access device; transmitting said digital object to said access device (see col. 11, lines 25-48);

registering said digital object as being in use by said access device (see col. 14, lines 15-23); and

denying further transmission of said digital object to any other access device while said digital object is in use by said access device (see col. 13, line 66-col. 14, line 2).

In respect to claim 2, Mott discloses the method of claim 1, further comprising the step of:

registering a plurality of access devices for receiving said digital object, said

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plurality of access devices having common rights of access to said digital object;
and

wherein said step of registering said digital object as being in use by said access device grants access to said digital object to all of said plurality of access devices having

common access rights, but to no more than one of said plurality of access devices at a time (see col. 13, lines 6-19, line 60-col. 14, line 2).

In respect to claim 3, Mott discloses the method of claim 2, wherein said plurality of access devices includes access devices of different types, and said digital object is transmitted to each of said types of access device in a form specific to each of said types of access device (see col. 11, lines 37-42).

In respect to claim 4, Mott discloses the method of claim 2, wherein said plurality of access devices includes access devices of different types, and said digital object is transmitted to each of said types of access device with a content specific to each of said types of access device (see col. 11, lines 33-42).

In respect to claim 5, Mott discloses the method of claim 1, further comprising the step of:

identifying said digital object with a unique identifying code, said unique identifying code being contained in a physical object (see col. 2, lines 9-19).

In respect to claim 6, Mott discloses the method of claim 5, wherein said physical object includes one of the group consisting of: a magnetic memory, a bar code, an optical memory, and an RF tag (see col. 18, lines 37-49, barcode on manufactured device).

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In respect to claim 7, Mott discloses the method of claim 1, wherein said step of transmitting said digital object to said access device includes transmitting; said digital object over a computer network (see col. 3, lines 50-53).

In respect to claim 8, Mott discloses the method of claim 7, wherein said computer network includes the Internet (see col. 3, lines 50-53).

In respect to claim 9, Mott discloses the method of claim 5, wherein said access device is capable of reading said physical object to access said unique identifying code and said step of requesting that access to said digital object be granted to said access device further comprises the step of reading said physical object (see col. 2, lines 9-19).

In respect to claim 10, Mott discloses the method of claim 1, further comprising the step of:

transferring access to said digital object from said one of said plurality of access devices to a non-registered access device, not stored as one of said registry; and disabling access to said digital object to said plurality of access devices stored in said registry while said non-registered access device has access to said digital object (see col. 3, lines 6-19 and col. 14, lines 3-14).

In respect to claim 11, Mott discloses the method of claim 1, further comprising the steps of:

establishing an encryption protocol for transmitting said digital information to said registry of access devices (see col. 14, lines 58-67);

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encrypting said digital information in accordance with said encryption protocol;

transmitting said digital information to said at least one of said access devices

having common access rights to said digital information in encrypted form (see col. 7, lines 24-42);

decrypting said digital information on receipt thereof by said at least one of said access devices having common access rights to said digital information.

In respect to claim 12, the claim limitation is a system claim that is substantially similar to method claim 1. Therefore claim 12 is rejected based on the similar rationale.

In respect to claim 13, the claim limitation is a system claim that is substantially similar to method claim 2. Therefore claim 13 is rejected based on the similar rationale.

In respect to claim 14, the claim limitation is a system claim that is substantially similar to method claim 5. Therefore claim 14 is rejected based on the similar rationale.

In respect to claim 15, the claim limitation is a system claim that is substantially similar to method claim 6. Therefore claim 15 is rejected based on the similar rationale.

In respect to claim 16, the claim limitation is a system claim that is substantially similar to method claim 9. Therefore claim 16 is rejected based on the similar rationale.

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In respect to claim 17, the claim limitation is a system claim that is substantially similar to method claim 10. Therefore claim 17 is rejected based on the similar rationale.

In respect to claim 19, Mott discloses the system of claim 12, further comprising means for setting a time for transmitting said digital object to said access device (see col. 11, lines 2-6).

In respect to claim 20, Mott discloses the system of claim 17, further comprising means for selecting which of said access devices stored in said registry will receive said digital information (see col. 11, lines 25-47).

In respect to claim 21, the claim limitation is a system claim that is substantially similar to method claim 11. Therefore claim 21 is rejected based on the similar rationale.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mott (U.S. Patent No. 6,170,060) in view of Ballantyne et al. (U.S. Patent No. 5,133,079, hereinafter Ballantyne).

In respect to claim 18, the system of claim 12, further comprising:

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means for registering a unique identifying code containing a location of said digital object, said means for registering including a physical object (see Mott, col. 11, lines 25-47);

a memory for storing a second registry of access devices for accessing said digital object, each of said access devices having common access rights to said digital object, at least one of said of access devices including a reader for reading said unique identifying code (see col. 2, lines 9-19); and

a second transmitter for transmitting said unique identifying code to a server on which said digital object is stored, and also for transmitting said second registry of access devices to said server (see col. 11, lines 25-47);

said manager including means for comparing said unique identifying code with a list of authorized codes of digital information (see col. 2, lines 9-19, col. 11, lines 37-42);

said first transmitter including means for transmitting said digital object to at least one of said access devices having common access rights to said digital object, when said unique identifying code corresponds to an authorized code; said manager further including means for denying access to said digital object to said access devices when said unique identifying code fails to correspond to an authorized digital object (see col. 2, lines 9-19);

said controller including means for disabling further transmission of said digital object to any other access devices after transmission of said digital object to said at least one of said access devices (see col. 13, lines 6-19, col. 14, lines 3-14).

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Mott does not explicitly disclose means said controller further including means for re-enabling the transmission of said digital object to said at least one of said access devices after receipt of a signal indicating that said digital object is no longer being stored in said at least one of said access devices to which it had been transmitted. However, Ballantyne discloses a customer's storage device allows only one replay, where upon the stored data is either erased or locked from further replay (see Ballantyne, col. 6, lines 39-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teaching of Mott's downloading digital data to playback devices with the teaching of Ballantyne's system of distribution of movie that allows customer's stored data to be erased or locked in order to prevent customer from continued replay.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (571) 272-3843. The examiner can normally be reached on 8:30-5:00 M-F.

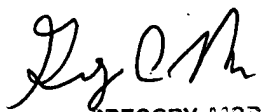
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran
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TT

December 15, 2004


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